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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,928	02/20/2002	Isreal Hicks	HICKS-1-1002	2184

7590 11/29/2004

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EXAMINER

CHAN, KO HUNG

ART UNIT PAPER NUMBER

3632

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,928

Applicant(s)

HICKS, ISREAL

Examiner

Korie H. Chan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-47 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings filed on January 20, 2004 are not approved in part for the reason that figures 1 and 6 contain new matter. The new figure 1 shows the middle section articulation (at 24) as having overlapping ends from the hook portion (26) and wrap section (22) which deviates from the original figure 1 which shows a continuous connected ends at (28) and constitutes new matter. Further, new figures 1 and 6 shows the nut as a wing nut which is not presented in the original figures 1 and 6 which shows a conventional annular nut. New figure 6 shows the overlapping portions at the articulation point 24 as being straight ends which deviates from the original figure 6 which shows the overlapping parts as curved and angled.

Claim Objections

Claims 36, 43, and 45 are objected to because of the following informalities: Claim 36, line 10, after "engage", one of "the the" should be deleted. Claim 43, line before last, the period before the comma should be deleted. Claim 45, line before last, after "positioning", - - of - - should be added. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 29-37 and 45-47 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a hanger having a continuous strip without articulation and a hanger having two sections with articulation, does not reasonably provide enablement for a strip or a continuous strip with articulation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The recitation of "a continuous strip" as recited in claim 26 or "a strip" as recited in claims 30, 33, 36, 45 denotes a single strip. However, claim 29 which depends from claim 26 recites that such single strip has a pivotable section or an articulation as is recited in claims 30, 33, 36, 45. Applicant's described invention with a single strip of material as shown in figure 7 does not have pivotable section nor articulation. On the other hand, applicant's embodiment with pivotable section or articulation shown in figures 1 and 6 is not of "a single strip" but rather two strips.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not discuss that the hook will hold the wheel at the same height as the axle of a vehicle supported by the horizontal member. Furthermore, the drawings does show a vehicle supported by the horizontal member from which the tire hanger is supported but rather the vehicle appears to be on a platform.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear in all of the independent claims whether applicant is claiming the combination of the tire hanger with a vehicle hoist, a horizontal member of a vehicle hoist, a wheel, and/or a wheel with axle hole. Again, it is examiner's position that the terms "arranged to", "configured to", or "for engaging" are recitations of intended use. Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Further, regarding claim 26, "first end arranged to wrap around" is vague and indefinite as there is insufficient structure recited to support the function of wrap around.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

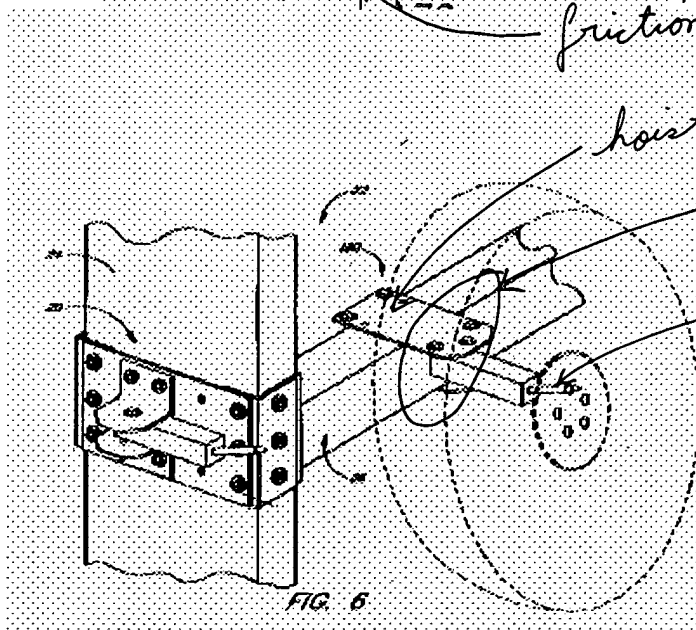
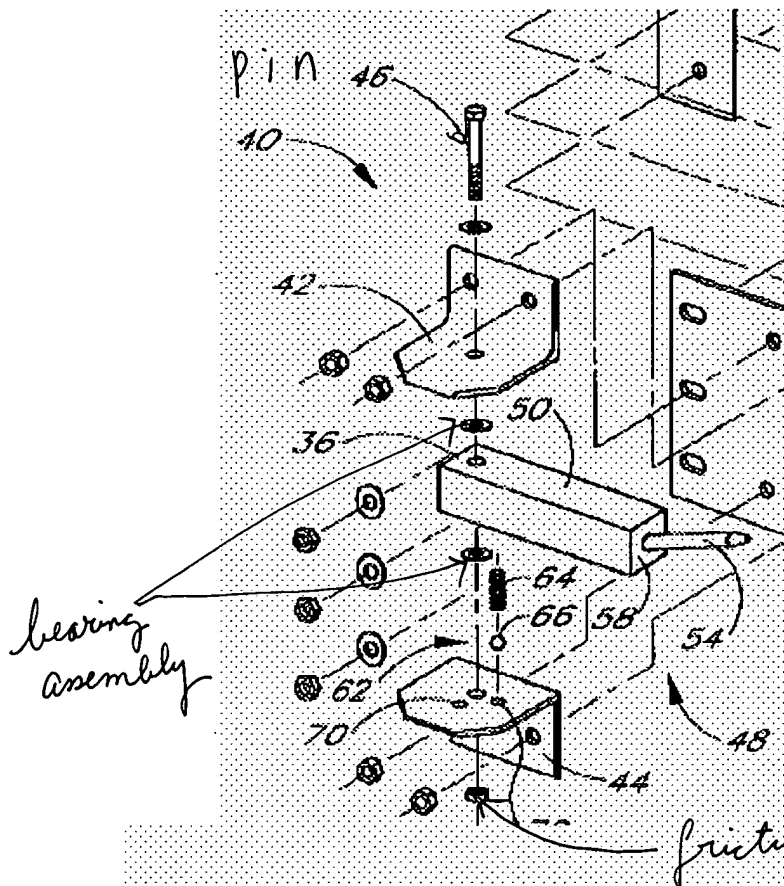
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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 21-25, 30-32, 38, 39, and 41-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Starling et al (WO 00/55031). Starling discloses a tire hanger (120, see illustration below) comprising a hoist wrap section having an open end arranged to removeably engage to the horizontal support member of a vehicle hoist; a tire hanging section arranged to engage axle of a wheel; and a middle section disposed between the hoist wrap section and the tire hanging section wherein the middle section having a length and having an articulated joint, whereby the hoist wrap section is shaped so as to wrap around the horizontal support member of the vehicle hoist. Further, Starling's hoist wrap is inherently can be slidably positionable along the horizontal support member at a user-selected a location when the nuts are loosened. Starling also further discloses the pivot joint includes a bearing assembly (see illustration below), a pin (46, figure 2), and a frictional locking device (nut).



Claims 26 and 27 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Hull (US patent no. 1,450,084). Hull discloses a tire hanger (figure 9) comprising a continuous strip of material, the strip comprising a first end (26) supported on a horizontal member (7), a second end hook configuration (the U bottom hook) to engage a wheel, and a middle section (8) having a length.

Applicant's intended usage language "configured to engage a vehicle hoist" is not accorded with patentable weight. Hull's tire hanger is capable of removable engagement with a horizontal support member of a vehicle hoist. See above regarding recitation of intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starling et al (WO 00/55031) in view of Huot (US patent no. 3,979,035). Starling disclosed all the claimed features of applicant's invention except for the hoist wrap end as being U-shaped. Huot discloses a U-shaped end (20) for wrapping around a horizontal support member (figure 2). It would have been obvious to one of ordinary skill in the art to have modify the hoist wrap of Starling such that it is of U-shaped as taught by Huot for quick mount and dismount of the hanger as taught by Huot.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull (US patent no. 1,450,084) in view of Huot (US patent no. 3,979,035). Hull disclosed all the claimed features of applicant's invention except for the hoist wrap end as being U-shaped. Huot discloses a tire hanger comprising a U-shaped end (20) for wrapping around a rectangularly cross-sectioned horizontal support member (figure 2). It would have been obvious to one of ordinary skill in the art to have modify the hoist wrap of Hull such that it is of U-shaped for mounting on rectangularly cross-sectioned horizontal support members as taught by Huot.

Response to Arguments

Applicant's arguments filed 9/20/2004 have been fully considered but they are not persuasive. Applicant continues to argument the recitation of intended use such as configured to removably engage a horizontal support member of a vehicle hoist. As stated earlier, a recitation of intended use must result in a structural difference. If the reference is capable of performing such intended use then the claim limitation is met. Regarding applicant's request that examiner pointed lines and columns where such capability is explicitly stated, such capability to perform the intended use does not have to be explicitly stated in the patent as long as it is inherent to one of ordinary skill in the art that such capability exist.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cooley and Collins demonstrate tire hanger and hoist combination.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 703-305-8079. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Korie H. Chan
Primary Examiner
Art Unit 3632

khc
November 24, 2004